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REMARKS

In the latest Office Action, the Examiner required restriction to one of two inventions, identified as inventions I and II under 35 U.S.C. §121. Applicants hereby elect invention Group I which contains claims 1-8, 17 and 18, with traverse.

Applicants would like to thank Examiner To for the courtesies extended to Applicants' attorney, Kevin T. Grzelak, during a brief telephonic interview conducted on September 14, 2005. During the interview, Applicants discussed the restriction requirement raised subsequent to a substantive Office Action and requested that the restriction/election requirement be withdrawn. Specifically, Applicants pointed out to the Examiner that the system and method claims are not distinct as noted by the Examiner in the Office Action and that the Species A and B identified by the Examiner are clearly not mutually exclusive. The Examiner agreed to reconsider the restriction requirement upon review of Applicants' remarks, which are repeated below.

The Examiner stated that inventions I and II are related as process and apparatus for its practice. Specifically, the Examiner stated: "In this case, the process as claimed can be practiced by a materially different apparatus or by hand, such as by a system for monitoring and diagnosing vehicle on-board devices from a management service."

Section 803 of the *Manual of Patent Examining Procedure* (MPEP) sets forth two criteria for a proper requirement for restriction between patentability distinct inventions, requiring: (a) the invention must be independent or distinct as claimed; and (b) there must be a serious burden on the Examiner if restriction is required. Section 806.05(e) of the MPEP further states that a process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (a) that the process as claimed can be practiced by another materially different apparatus or by hand; or (b) that the apparatus as claimed can be used to practice another and materially different process.

Invention I identified by the Examiner includes claims 1-8, 17 and 18 drawn to a system for providing personalized context information for use with on-board vehicle devices, whereas invention II identified by the Examiner includes claims 9-16 and 19 drawn to a method of providing personalized context information for use with on-board vehicle devices.

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The Examiner stated that the process as claimed can be practiced by a materially different apparatus or by hand, such as a system for monitoring and diagnosing vehicle on-board devices from a management service. However, the preamble in claim 1 is directed to a system for providing the same information recited in claim 9. The Examiner has failed to show that the process of claim 9 can be practiced by a materially different apparatus. The exemplary system for monitoring and diagnosing vehicle on-board devices from a management service identified by the Examiner is not necessarily a materially different apparatus from the system claimed in claim 1.

Accordingly, the Examiner has failed to show that the process as claimed in Group II can be practiced by another materially different apparatus or by hand. Additionally, there is no serious burden on the Examiner such as to require restriction of the present application. All of claims 1-19 can and should be searched and examined together by the Examiner without requiring any serious burden. Applicants request that the restriction requirement be withdrawn and that inventions I and II be rejoined and all of claims 1-19 be prosecuted together in the present application.

Additionally, the Examiner stated upon election of invention I or II, the Applicant is further required under 35 U.S.C. §121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable: (A) personal context information comprises user preferences; and (B) personal context information comprises an address pointer. The Examiner also stated that currently, no claims are generic. Applicants submit that claim 1 is generic as to invention I and claim 9 is generic as to invention II. The Examiner required an identification of the species that is elected consonant with this requirement listing all of claims readable thereon. Applicants hereby elects species A which includes claims 1-8 and 18, as opposed to claim 17, for invention I.

As to when it is proper to restrict the claims to species, MPEP §806.04(f) clearly requires that the claims to be restricted to be different species must be mutually exclusive. MPEP §806.04(e) provides that the species are always the specifically different embodiments. Applicants respectfully submit that none of the claims made-up of the species A and B are

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mutually exclusive of the claims of the other specified species. The Examiner has not shown any distinct characteristics for each of the species as evidenced to support mutual exclusivity. The user preferences of species A are not mutually exclusive of the address pointer of species B, and, in fact, both can be used together in the same system. Accordingly, Applicants respectfully request that the requirement to restrict the claims to a specific species be withdrawn.

In view of the above election, with traverse, the claims covering inventions I and II and species A and B, Applicants respectfully request that all of claims 1-19 be considered and examined in this application consistent with the Examiner's earlier Office Action.

If the Examiner has any questions regarding this response, or if the application can be readily placed in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

  
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